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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966.

No. 1225

THE COLSON CORPORATION,
Petitioner,

vs.

EVEREST & JENNINGS, INC., GERALD M. JENNINGS, DAVID D. JENNINGS,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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THE GUNTHROP-WARREN PRINTING COMPANY, CHICAGO

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vs.

EVEREST & JENNINGS, INC., GERALD M. JENNINGS, DAVID D. JENNINGS,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner, the Colson Corporation, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on January 5, 1967.

OPINIONS BELOW.

The opinion of the United States District Court for the Northern District of Illinois, Eastern Division, entered on August 18, 1965 is unreported. (P. App. 260.)[1] The opinion of the Court of Appeals, printed in Appendix A *infra* at page 15 and is reported at 371 F. 2d 240.

1. Plaintiffs-Appellants' Appendix in the court below will be referred to herein as (P. App. . . . .); the Defendants' additional Appendix as (D. App. ....).

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered on January 5, 1967. Jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

QUESTION PRESENTED.

Is the clear policy of Congress and this Court to discourage frivolous patent litigation and fraudulent procurement of patents obstructed when, despite findings of the District Court that

(1) the patent sued upon was invalid because the plaintiffs-patentees had publicly used and sold the alleged invention extensively for several years before filing the application for the patent in suit, and

(2) that plaintiffs obtained their patent by concealing their own extensive prior public use and sale of the alleged invention from the Patent Office,

the trial and appellate courts nevertheless failed to award attorney fees to the prevailing and non-infringing defendant?

STATUTE INVOLVED.

The statutory provision involved is § 285 of the patent laws (35 U. S. C. 285). This section provides, in full:

> "The court in exceptional cases may award reasonable attorney fees to the prevailing party."

STATEMENT.

This suit for patent infringement and injunction was brought by Everest & Jennings Inc. against Colson Corporation on September 11, 1961. The jurisdiction of the District Court was invoked because the case arises under the

patent laws. The original complaint charged infringement of two patents involved in wheelchair construction: the first a so-called one-arm drive, Patent No. 2,431,112 (D. App. 3) which Everest & Jennings later dropped from the suit, and the second a swinging detachable footrest, Patent No. 2,592,449 (sometimes referred to as the "Miller patent"—P. App. 291). Answering the charges of infringement, Colson asserted inter alia, that the patents were invalid because of lack of invention and because of anticipation through prior public use and sale by plaintiff. (P. App. 7.)

In 1946 Everest & Jennings began manufacturing and selling a combination wheelchair and footrest referred to generally as the "prior art chair", although the device in question is, more particularly, a swinging detachable footrest and wheelchair combination. Everest & Jennings manufactured and sold the prior art chair in commercial quantities from 1946 to 1950, all before the date (November 19, 1950) the patent application was filed. (Finding No. 6, P. App. 262.) The Miller patent, No. 2,592,449, purporting to cover the prior art chair, was issued April 8, 1952 to Everest & Jennings as assignee of the original applicant, the "inventor" Jack C. Miller. (P. App. 291.) At filing and during solicitation Everest & Jennings failed to exhibit to the Patent Office its almost idential prior art chair. Likewise, none of the numerous pintle hinge patents which crowded the prior art field was exhibited to the Patent Office during solicitation of the patent in suit or cited by the Patent Office Examiner. (Finding No. 10, P. App. 264-265.)

In 1956, after the Miller patent issued, Colson began manufacturing and selling wheelchairs in combination with the swingable and quick detachable footrest in several versions. Sales of one version by Colson brought notice of infringement from Everest & Jennings in March of 1960, and upon receipt Colson immediately stopped selling the

accused version. (P. App. 207.) Between March and August of 1960, Colson sold two versions of the wheelchair footrest combination which Colson adopted specifically on the advice of counsel in order to avoid any possible infringement of the Miller patent. On August 30, 1960, at Colson's invitation, Everest & Jennings' attorney and principal executive officer, Mr. Gerald C. Jennings, Jr., inspected Colson's chairs at a San Francisco exhibition. (P. App 209.) After this date Colson heard nothing from Everest & Jennings; no comment, no acknowledgment of the disclosures at the San Francisco exhibition, and no protests until the complaint in this action was served in September of 1961.

Throughout 1962, 1963 and 1964 Colson engaged in extensive pretrial discovery with respect to the claims of infringement of both the Miller and the one-arm drive patents. Colson filed numerous requests for admissions (172) and interrogatories (128) and took depositions of Everest & Jennings' officers as well as Mr. Jack C. Miller, the alleged inventor. Over three years after filing suit, on January 13, 1965, and only after the seventh group of Colson's requests for admissions and the third group of Colson's interrogatories to Everest & Jennings had been filed, Everest & Jennings finally abandoned its claims of infringement of the one-arm drive patent, with prejudice, from the suit. (D. App. 2.)

Hearings were held in the District Court for the Northern District of Illinois, Eastern Division in October, 1964, and February, 1965. On August 18, 1965 judgment was entered holding Everest & Jennings' footrest Patent No. 2,592,449 invalid (1) because of obviousness and lack of invention; (2) because Everest & Jennings had made public use and sale in commercial quantities of its own prior art chair for a period of more than one year prior to the date of patent

application; and (3) because Everest & Jennings had concealed its prior art chair from the Patent Office. Further, the District Court held that none of the claims of this patent, albeit invalid, had been infringed by Colson. (P. App. 269.)

The District Court specifically found the prior art chair, which was manufactured and sold extensively by Everest & Jennings at the time it pursued the patent application, to be "substantially and essentially identical with the patented chair in structure, function, mode of operation and results." (Finding No. 6, D. App. 262.) The District Court also found the alleged differences between the prior art chair and the patented chair to be immaterial.

> "All of the introduction of the Miller patent in suit, all the expressed objects and all of the avowed purposes and accomplishments of the alleged invention of that patent (contained in the first column thereof, and in the second column down to the description of the drawings) *are exemplified, accomplished and embodied as fully and particularly in the said Prior Art E. & J. Chair as they were in the variant thereof purporting to be patented in the patent in suit.*" (Emphasis supplied.) (Finding No. 7, D. App. 263.)

Nevertheless the District Court refused to award the attorneys fees, $26,704.21 (D. App. 57) sought by Colson. The Court of Appeals affirmed the District Court's holding that the patent was invalid. Likewise it upheld the District Court's refusal to grant attorneys fees to Colson, merely stating:

> "Where the trial court has made no finding of bad faith, such a finding cannot readily be made on review from a cold record. We find none here, *Cf. Talon Inc.* v. *Union Slide Fasteners, Inc.*, 266 F. 2d 731, 739 (9th Cir. 1959)."

REASONS FOR GRANTING THE WRIT.

> "It is not contemplated that the recovery of attorney's fees will become an ordinary thing in patent suits, but the discretion given the court in this respect, in addition to the present discretion to award triple damages, will discourage infringement of a patent by anyone thinking that all he would be required to pay if he loses the suit would be a royalty. The provision is also made general so as to enable the court to prevent a gross injustice to an alleged infringer.'"

It is clear that Congress intended § 285 to discourage frivolous patent claims and infringement as well as to compensate prevailing parties who are victimized by bad faith patent litigation. The decision of the Court of Appeals below should be reviewed because it erroneously interprets § 285 of the patent laws in refusing to find the instant case "exceptional" so as to justify the award of attorneys fees, thereby disrupting the statutory policy designed by Congress to discourage the filing and prosecution of groundless patent claims or defenses. From the record and the District Court's express findings, the "exceptional" nature of this case is manifest.

The far broader significance of the error below arises because of the great volume and complexity of patent litigation which exists at the district court level and the need to clarify and settle the question, one of first impression for this Court, of the circumstances under which attorneys fees *should* be awarded in patent cases in order to effectively carry out Congress' express policy of discouraging frivolous patent litigation. Furthermore, this Court in *Walker Process Equipment Inc.* v. *Food Machinery & Chemical Corp.*, 382 U. S. 172 (1965) sent a clear message to patent applicants and the lower courts that fraudulent conceal-

2. S. Rep. No. 1503, 79th Cong. 2d Sess. 1387 (1946).

ment of an applicant's relevant prior art will result in dire consequences, a message to which the Court of Appeals for the Seventh Circuit still, as in *Walker,* fails to give due credence. Finally, because the opinion of the Court of Appeals below is in conflict with decisions in the Ninth Circuit, the guidelines necessary for a uniform national application of attorneys fees awards in patent cases have been confused and remain unsettled.

1. **Error Below:** The District Court made explicit findings that Everest & Jennings *itself* manufactured and sold in commercial quantities its prior art chair for more than three years before the patent application was filed in November of 1950. Further, Everest & Jennings concealed its identical prior art chair from the Patent Office at the time of application and during the patent solicitation. The District Court and the Court of Appeals therefore erred in not holding that "bad faith" was necessarily inherent in plaintiff's concealment of its own identical prior art chair and in prosecuting a suit based upon a patent so fraudulently obtained. If the instant case is not an "exceptional" one under Section 285 of the patent laws then no patent case really can be.

The Court of Appeals has excused Everest & Jennings on the nominal ground that the District Court did not find them guilty of bad faith. But Everest & Jennings did not merely fail to exhibit prior art patents of debatable relevance they might have been aware of, but in fact they knowingly and wrongfully claimed and obtained a patent for their own prior art device, which they were busy making and selling down to the day and hour of making this application for this patent in suit. And to compound the mischief here, as the District Court found, the prior art chair not only lacked invention, but in any event Colson never infringed anything! (Finding No. 5 and Conclusion of Law No. 5, P. App. 261 and 269.)

Knowledge and concealment of someone else's relevant prior art has traditionally been grounds for finding the kind of bad faith justifying an award of attorneys fees. In *Shingle Product Patents, Inc.* v. *Gleason,* 211 F. 2d 437 (9th Cir. 1954), the court stated (at p. 441):

> "The district court specifically found that plaintiff, and its officers and directors, knew or should have known that the patents were invalid and that they 'commenced and prosecuted this action in bad faith, without justification, and without any reasonable belief in the merits of the claims alleged.' *As the basis for its finding of bad faith the court points out that plaintiff-appellant had knowledge of the Jackson, Burt, and Austrian patents and of the prior public uses of preformed wood shingle units* in Oklahoma and California." (Emphasis supplied.)

For stronger reasons if the prior art which plainly describes and anticipates an applicant's claimed invention is the applicant's *own device,* manufactured and sold commercially by him, the findings of unfairness and bad faith should be beyond the range of discretion and should be compelled as a matter of law.

Thus the District Court erred in not pursuing its otherwise explicit findings to the manifest conclusion of bad faith and the sanction of an award of fees. The lower court did not discuss or analyze the attorneys fees claim. Nor did it make any findings to support its disallowance of fees. However, the denial of fees is a *non sequitur* to the District Court's earlier findings that Everest & Jennings itself manufactured and sold commercially the prior art chair, in addition to concealing it from the Patent Office.

The Court of Appeals compounded this error by failing to examine the trial court's findings and to recognize their basic internal inconsistency. Instead of analyzing the contents of the trial court's findings which compel a finding

of unfairness and bad faith, the Court of Appeals simply accepted the trial court's unsupported inductive leap that "the defendant is not entitled to an allowance of attorneys' fees." (Conclusion of Law No. 6, P. App. 269.)

Acknowledging that a trial court's discretion in refusing to award attorneys' fees should not be upset unless a clear abuse discretion is shown, *e. g. Hoge Warren Zimmerman Co.* v. *Nourse & Co.*, 293 F. 2d 779 (6th Cir. 1961), some effort by the reviewing court must be made to determine whether the exercise of discretion was or was not abused, rather than mere unquestioning adherence to a trial court's conclusion. No such effort can be found in the opinion of the court below, aside from a cursory reference to the "cold record." This failure to take a careful look at the District Court's findings is all the more puzzling because the Appeals Court had, in affirming the finding of invalidity, quoted extensively from the findings, including those which clearly demonstrate Everest & Jennings' knowledge and concealment of its prior art chair from the Patent Office. Again consider the District Court's Finding No. 6 (P. App. 262):

> "The said Prior Art E. & J. Chair was manufactured and sold by plaintiffs and/or their predecessors from about 1946 through about the year 1949. It was substantially and essentially identical with the patented chair in structure, function, mode of operation and results."

The findings of Everest & Jennings, prior public use and sale and of concealment of such data from the Patent Office establish bad faith in procuring its patent. Its filing of a suit against Colson, thereby necessitating a large expenditure for attorneys' fees in defense of Colson's proper activity, clearly establishes the "exceptional case" and requires that Colson be reimbursed for the fees incurred as a proximate result of Everest & Jennings, wholly wrongful activity.

2. **Conflict in the Circuits:** More important than the error below is the conflict of decision which results. The Court of Appeals for the Ninth Circuit in *Shingle Product Patents Inc.* v. *Gleason,* 211 F. 2d 437 (9th Cir. 1954), affirmed the trial court in assigning as a basis for its finding of bad faith the fact that the applicant had knowledge of prior art and prior public use of the patented device. In another Ninth Circuit case, *Talon Inc.* v. *Union Slide Fastner, Inc.,* 266 F. 2d 731 (9th Cir. 1959), that court refused to disturb a finding of bad faith and an award of attorneys fees where the trial court found only that the action was brought by the patent holder "without reasonable belief in the validity of the patent", surely a far lesser showing of bad faith and unfairness than exists in the instant case where the issue is not one of "reasonable belief" in the validity of a patent, but obvious concealment of the applicant's prior art chair from the Patent Office.

There are, as might be expected, very few reported cases in which patentees have procured patents by fraud and then vexatiously sued on such patents. One case in which such allegations were made and which came to this Court on review of a grant of motion to dismiss is *Walter Process Equipment Inc.* v. *Food Machinery & Chemical Corp.,* 382 U. S. 172 (1965). Reversing the Seventh Circuit Court of Appeals, this Court held that patents procured by fraudulently concealing prior art are not entitled to anti-trust exemption, stating (at p. 177):

> "To permit recovery of treble damages for the fraudulent procurement of the patent coupled with violations of § 2 accords with these long-recognized procedures. It would also promote the purposes so well expressed in Precision Instrument, supra, 324 US at 816, 89 L'ed at 1387:
>
> > 'A patent by its very nature is affected with a public interest . . . (It) is an exception to the general rule against monopolies and to the right

> to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope.' "

One other such decision which was rendered before *Walker* and, though a district court case, is directly in point is *Stock Equipment Co.* v. *Beaumont Birch Co.*, reported only in 140 USPQ 134, (E. D. Pa. 1963) and included as Appendix B at page 23. In this case the court held that attorneys' fees were proper and necessary when the plaintiff-patentee concealed KNOWLEDGE OF DEFENDANT'S prior art from the patent office and then sued for infringement, a decision plainly conflicting with that in the instant case, yet involving an almost identical factual situation.

The Court of Appeals decision in the instant case conflicts with the decisions in the Ninth Circuit cited above as well as the decision in *Stock Equipment Co.* v. *Beaumont Birch Co., supra,* and also conflicts with the principle announced in this Court's opinion in the *Walker Process* case. The Ninth Circuit cases have one basic factual element in common: the applicant obtained a patent anticipated by prior art merely known to him. In the instant case not only was Everest & Jennings aware of the relevant prior art which anticipated and was substantially identical to the patent applied for, but the prior art was embodied in Everest & Jennings' own chair which it had manufactured and sold commercially and which it failed to exhibit or cite in its oath to the Patent Office. The conflict is more than one of principle with the decisions cited above; the conflict is a real and direct one stemming from an erroneous application of § 285 of the Patent Laws by the Court of Appeals below to a factual situation plainly more aggravated in its

"exceptional" nature than those involved in the Ninth Circuit decisions cited above.

3. **Importance:** The question of abuse of discretion in failing to allow attorneys fees under 28 U. S. C. 285 is one of first impression for this Court. The importance of announcing the proper standards to be applied in determining an award of attorneys fees in patent cases involves far more than the immediate concern of Colson to be reimbursed for the attorneys' fees which it has incurred in the defense of plaintiff's tainted claim in the instant case. What is involved is the much broader and more significant question of the manner in which this Court shall administer the flow of judicial business generated under the patent laws. Patent cases are necessarily complex, expensive and time consuming and, for these reasons, operate as a more troublesome clog in the lower courts' dockets.

Equally important is the policy against fraudulent procurement of patents by knowingly concealing relevant prior art. In the *Walker Process* case, Food Machinery and the Solicitor General alleged that Walker withheld knowledge of prior art in order to procure, fraudulently, a patent which it in turn used to gain competitive market advantages by threats of prosecution for infringement. This kind of economic leverage by threats of prosecution for infringement under invalid patents poses serious problems in the patent field. A clarification of the attorneys fees question would undoubtedly have a far reaching effect on the volume and character of patent litigation in this country. So long as decisions such as the one below remain uncorrected, the next patentee-plaintiff who has procured his patent fraudulently can write off any added risk of having to pay attorneys fees if his frivolous patent infringement claim is ultimately exposed as such, at least in the 7th Circuit. More than just reimbursing the imposed upon party for gross injustice, the importance of the award of fees lies

in its preventative force, a force which applies equally to the irresponsible infringer as well as the fraudulent enforcer; a force which Congress plainly intended Section 285 to have in discouraging frivolous patent litigation.

The instant case is a fit example of the expensive, time-consuming and laborious process of exposing invalidating prior art through litigation, a process which might have been unncessary if the risk of paying attorneys fees to a prevailing defendant had been a factor of any significance in Everest and Jennings making the original decision to sue, which it was not so long as it chose to bring its action in a court within the reviewing jurisdiction of the Court of Appeals for the Seventh Circuit.

CONCLUSION.

For the reasons set forth above, it is respectfully submitted that this petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A.

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

September, 1966 Term—January, 1967 Session.

Nos. 15511 and 15512.
Everest & Jennings, Inc., Gerald M. Jennings; Harry C. Jennings, Jr., and David D. Jennings,
Plaintiffs-Appellants and Cross-Appellees,

vs.

The Colson Corporation,
Defendant-Appellee and Cross-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

January 5, 1967.

Before HASTINGS, *Chief Judge*, DUFFY, *Senior Circuit Judge* and SWYGERT, *Circuit Judge*.

HASTINGS, *Chief Judge*. Everest & Jennings, Inc., a California corporation, Gerald M. Jennings, Harry C. Jennings, Jr., and David D. Jennings, appellants [Jennings], manufacturer and individual trustee owners of the patent in suit respectively, have appealed from a judgment of the district court finding their United States Letters Patent No. 2,592,449 "Removable Footrest for Wheel Chairs," issued April 8, 1952 to Jack C. Miller, to be invalid and

not infringed by wheel chair footrests manufactured by the Colson Corporation, a Delaware corporation, having a regular and established place of business in Chicago, Illinois.

Jennings' '449 combination patent, relating to improvments in wheel chairs and wheel chair footrests, describes footrest structures for wheel chairs. The described footrest can be locked in a normal position for use on an upright forward leg of the wheel chair, or released to swing laterally from its position in front of the chair and thence removed entirely from the frame of the chair.

The mobility and detachability of the footrests, which normally protrude to the front, are desirable characteristics, for with them wheel chairs can be made to approach upright objects and structures, such as tables or beds, more closely than wheel chairs with permanently or rigidly mounted footrests. Similarly, the removable footrests are claimed to facilitate storage or transportation of wheel chairs.[1]

As found by the district court, the combination patent comprises

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1. The patent in suit contained five claims, the validity of each of which was placed in issue. Typical of the first four claims is claim 4, which reads:

> "4. In combination, a wheel chair having upright forward legs, gudgeons on the legs, footrest structures having pintles receivable downwardly in the gudgeons enabling the footrest structures to be applied and removed from the legs and when in applied position to swing laterally with respect to the legs, and means for releasably locking the footrest structures against swinging movement and against removal from the legs comprising a knuckle on each leg, a knuckle on each footrest structure alignable therewith and locking pins receivable in the aligned knuckles, the knuckles on the footrest structures being adapted to assume positions beneath the knuckles on the legs as and for the purpose described."

Claim 5 of the patent in suit merely adds pintles of unequal length to the other claims of the patent in suit.

"(1) a wheel chair with upright forward legs, (2) footrest structures hingedly and removably connected to the legs for swinging motion about vertical axes from straight ahead positions to rearward and outward positions, (3) hinges connecting the legs and footrest structures, and (4) means for releasably locking the footrests against swinging and against removal."

Two gudgeons or sockets secured to the outer sides of the front legs of the wheel chair receive pintles of equal or unequal length, which are attached to the tubular frame of the footrest and which are made to fit into the sockets. The footrest is attached to the front leg of the chair by placing the pintles in the sockets; removed by withdrawing them. A knuckle is secured to the inner sides of the front legs of the wheel chair and a similar knuckle is attached at the top of the footrest frame, to register with the wheel chair knuckle when the footrest is swung to extend straight forward from the upright leg of the chair. Each of the knuckles has a hole in it so that when the knuckles of the chair and footrest are aligned, a locking pin can be slipped into the hole to hold the footrest in place. When the locking pin is withdrawn, the footrest can be swung aside and removed.

The district court found:

"6. The whole combination of elements purporting to be patented in the patent in suit, and every feature of alleged novelty of each element, excepting only the pintle hinge (with pintles of equal or unequal length) of the patent compared with the bolt and nut hinge of prior use, had been in public use and on sale, and sold in commercial quantities, by plaintiffs and their predecessors, for more than one year before the plaintiff filed the application for the patent in suit. The prior public use and sale combination chair and footrest is referred to herein as the Prior Art E. & J. Chair. * * *. The said Prior Art E. & J. Chair was manufactured and sold by plaintiffs and/or their pred-

> ecessors from about 1946 through about the year 1949. It was substantially and essentially identical with the patented chair in structure, function, mode of operation and results. * * *. Its specific difference in structure from the patented chair * * * comprised merely the difference between its bolt and nut hinges, compared with the pintle hinges of the patent, which however, did not alter the sameness of the function, operations or results of the two chairs, excepting in the degree of convenience with which the parts of the hinge could be detached and reassembled. * * *. Pintle hinges in analogous arts with pintles of equal and unequal length were old and well known long prior to the alleged invention of the patent in suit * * *."

The district court further found that the changes made in the prior art E. & J. chair, which resulted in the patented combination

> "8. * * * required no more than the solution of simple engineering problems well within the learning and scope of those skilled in the art. * * *."

The district court held that Jennings' '449 patent was invalid because it did not disclose invention. It was further held invalid because of Jennings' prior public use and sale for a period of one year prior to the date of patent application. None of the claims of the '449 patent was found to be infringed.

On appeal, Jennings contends that the prior art E. & J. chair, of which the patent office had no notice, did not anticipate the claims of the patent in suit, that the claims of the patent were patentable over the prior art, and that Colson's construction infringes the patent.

We agree with the district court that the pintle hinge patents, Swiss Patent No. 63,067; Gillespie, U. S. Patent No. 484,361; Fernald, U. S. Patent No. 1,087,576; Long, U. S. Patent No. 373,837; and Herr, U. S. Patent No.

898,647, none of which was cited by the patent examiner, were all pertinent prior art for the '449 patent in suit.

While there is a presumption of validity arising from the grant of a patent, no such presumption exists as against prior art not before the patent office. *Skirow* v. *Roberts Colonial House, Inc.*, 7 Cir., 361 F. 2d 388, 390 (1966), and cases cited there.

The inventive step from nut and bolt to pintle hinge was, as the trial court found, "no more than the mere choice and selection of size and shape among old devices, with the result of but small increased or changed efficiency and convenience."[2] The use of advice well known in the prior art to obtain results revealed in the same prior art does not constitute patentable invention. *Cf. Skirow, supra.*

In view of the prior pintle hinge art, we hold that the '449 patent did not constitute a patentable invention, for the alleged invention would have been obvious at the date of the invention of those skilled in the relevant art. 35

2. Finding 8. In finding 9, the trial court stated: "The Miller patent in suit compared with the Prior Art E. & J. Chair accomplished no more than putting the old pintle hinges to a new use with natural and expected results, * * *." In finding 10, the trial court further stated: "* * *. The pintle hinge of the patent in suit was identical with the bolt and nut hinge of the Prior Art E. & J. Chair in respect to all the swinging motions of the footrest in relation to the chair, and was substantially and essentially identical in respect to removability from the chair, and re-attachment thereto; being more conveniently removable only in degree compared with the Prior Art E. & J. Chair. * * *. The specific means for locking the footrest against swinging and removal, comprising aligned, vertically apertured knuckles and a locking pin, were substantially identical in structure, function, mode of operation and results in the patent chair and in the Prior Art E. & J. Chair * * *." And in finding 13, the trial court added: "Plaintiffs' patent came late into the art already crowded with substantially identical chair and footrest combinations, including principally plaintiffs' own Prior Art E. & J. Chair, and teaching pintle hinges with equal and unequal pintles in analogous uses. * * * [citing]. The advance, if any, made by the patent in suit was negligible." We agree.

U.S.C.A. § 103. *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966); *Skirow, supra,* at 390, and cases cited there; *Strzalkowski, et al.* v. *Beltone Electronics Corporation*, 7 Cir., ... F. 2d ....., (opinion filed December 6, 1966). *Cf. United States* v. *Adams*, 383 U. S. 39 (1966); *Walt Disney Productions* v. *Fred A. Niles Communications Center, Inc., et al.*, 7 Cir., ... F. 2d ..... (opinion filed November 9, 1966).

Since we agree with the district court that the patent in suit is invalid because of obviousness, we do not reach the other grounds of invalidity asserted by Colson.

Further, having found the '449 patent to be invalid, we need not here reach the question of infringement.

Colson, citing *Townsend Company* v. *M.S.L. Industries*, 7 Cir., 359 F. 2d 814 (1966), urges that it is entitled to an award for reasonable attorney fees because Jennings alledgedly acted in bad faith in failing to bring its prior art E. & J. chair to the attention of the patent office. Had it done so, Colson argues, Jennings would not have been able to obtain the '449 patent and therefore could not have instigated this litigation against Colson.

In *Townsend,* the trial court found the plaintiffs had brought their action in bad faith. The question on appeal was the propriety of the trial court's issuance of summary judgment, that is whether there existed a genuine issue of material fact. Finding no such issue of fact, this court upheld the summary judgment of the trial court.

In the instant case, there was a trial, and the trial court, while finding and concluding the '449 patent invalid for anticipation and lack of patentable invention and not infringed by Colson's constructions; made no finding of bad faith in the application for the patent, and denied Colson an allowance of attorneys' fees.

Where the trial court has made no finding of bad faith, such a finding cannot readily be made on review from a

cold record. We find none here. *Cf. Talon, Inc.* v. *Union Slide Fastener, Inc.*, 9 Cir., 266 F. 2d 731, 739 (1959).

We hold that the district court did not abuse its discretion in failing to award attorneys' fees because of the alleged bad faith of Jennings.

In sum, we hold that he patent in suit clearly fails to meet the nonobviousness requiremnt of 35 U.S.C.A. § 103, and that there was no showing of bad faith requisite to justify an award of attorneys' fees.

The judgment of the district court is affirmed.

AFFIRMED.

APPENDIX B.

United States District Court, E. D. Pa.
Stock Equipment Co. *vs.* Beaumont Birch Co.
Decided November 14, 1963.

STEEL, *Judge.*

STEEL, *District Judge.*

In issue is the validity of claim 3 of U. S. Patent # 2,792,150 (hereinafter "patent 150"), and the infringement thereof by defendant. Other aspects of the controversy raised by the pleadings have either been stipulated out of the case or decided adversely to plaintiff by the court when it partially granted the motion of defendant to dismiss at the close of plaintiff's evidence. Plaintiff's claim of infringement has been limited, by stipulation, to the overhead pinion type of coal gate of valve construction shown in defendant's catalog sheet No. 7152.5B.

Plaintiff, Stock Equipment Company, is incorporated in Ohio and has its principal place of business at Cleveland, Ohio. Defendant, Beaumont Birch Company, is incorporated under the laws of Pennsylvania and has its principal place of business at Philadelphia, Pennsylvania. The action arises under the patent laws of the United States, 35 U. S. C. § 271. The court has jurisdiction under 28 U. S. C. § 1338(a).

The 150 patent was applied for by A. J. Stock on February 4, 1955 and was issued on May 14, 1957. Stock has assigned the patent to plaintiff.

The patent relates to a gate or valve (interchangeable terms) the purpose of which is to control the flow of bulk material such as coal, coke, sand, limestone and the like from a storage bin into a furnace located beneath the bin.

The invention is claimed to be an improvement over the valve structure disclosed in U. S. Patent # 2,238,296 issued to the same inventor on April 15, 1941 (hereinafter "patent 296"). According to the 150 patent the structure which it

describes is known in the trade as a rack and pinion bulk material valve or gate. These are most frequently used with large commercial boilers, as, for example, those employed in electricity generating plants.

Claim 3 of the 150 patent claims an apparatus which is enclosed in a dustproof casing. An inlet conduit from the storage bin vertically penetrates the upper portion of the casing and extends downwardly into the casing parallel with a portion of the walls of the casing. The coal or other material enters the casing through this conduit. An outlet opening exists in the bottom of the casing. When the valve is open the coal or other material passes from the casing through the outlet to the furnace below. The gate plate which opens and closes the outlet consists of a U-shaped plate with a flange integrally affixed to the upper portion of each vertically extending leg of the gate. Each flange is slidably supported on a plurality of rollers mounted on the inner walls of the casing and is provided with a longitudinally aligned plurality of oblong holes defining rack sections. One end of an operating rod extends through the casing and contains a handwheel by which it may be turned one way or the other by manual or mechanical rotation. Affixed to transversely opposite sides of the operating rod within the casing are a plurality of pinion gears. These are located above the flanges of the U-shaped gate and engage the rack sections of its flanges. Linear horizontal motion is imparted to the U-shaped gate by turning the hand wheel affixed to the operating rod. In this way the U-shaped gate is made to open and close. When open, it permits the coal or other material to flow from the hopper into the furnace; when closed, it prevents such movement.

Plaintiff and defendant both are, and for some years have been engaged in the business of manufacturing and selling bulk material handling apparatus.

Since December 23, 1958, defendant has been manufacturing and selling a coal valve which embodies every element of claim 3 of the 150 patent. The construction of defendant's valve is shown in its catalog sheet # 7152.5B. If plaintiff's 150 patent is valid, it has been and is being infringed by defendant.

Although the parties differ as to the significance of the prior art insofar as it bears upon the validity of claim 3 of patent 150, there is no dispute as to what the prior art consisted of.

Commencing at least as early as 1937, plaintiff's predecessor began to manufacture and sell coal valves substantially of the construction shown and described in its 296 patent.

From 1915 until the present defendant has manufactured and sold coal gates with solid tooth racks with pinions mounted above the racks.

Since at least 1925 defendant has been manufacturing and selling coal and ash gates of the rack and pinion type with the operating pinion for the racks mounted sometimes above and sometimes below the racks. The racks have sometimes been constructed with solid teeth and sometimes with open teeth. The gate plates have sometimes been of a U-shaped construction and sometimes of a flat plate construction. Since at least 1942 defendant has manufactured and sold coal and ash gates enclosed in a dust-tight casing.

United States patent # 760,772 which was issued to the Andersons in 1904 discloses the use of pinions mounted above open tooth racks used to move a slidable gate structure employed in supplying granular or pulverulent materials from a bin to a point of discharge beneath.[1]

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1. [1] The allowance by the Patent Office of the 150 patent, although Andersons' patent # 760,772 was cited against it, is not of controlling significance. The standard of inventiveness employed by the Patent Office is far below that applied by the Courts,

The coal gate which the defendant has been making and selling since 1942 is essentially the same as that specified in claim 3 of plaintiff's 150 patent except that in defendant's valve the driving pinions were mounted below the open toothed racks on the flanges of the plate, whereas claim 3 specified that the pinions should be above the plate, and except that the configuration of defendant's gate plate varied slightly from that which plaintiff has manufactured under claim 3.[2]

From what has been said it is apparent that each of the essential elements of claim 3 of the 150 patent is old in the art and antedated plaintiff's alleged invention by many years. Confronted by this proof, plaintiff was driven to the position of asserting, not that any element of claim 3 was new or novel, but that invention lay in the combination as an entirety.

[2] It is, of course, true that invention may be present when old elements are combined in such a way so as to produce an entirely new and useful result or function. In such circumstances the invention rests upon the novel result produced by the combination, a result which is entirely separate and distinct from the serviec performed by any or all of the elements or by a mere aggregation. *Griscom-Russell Co.* v. *Westinghouse Electric & Mfg. Co.*,

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Picard v. *United Aircraft Corporation*, 128 F. 2d 632, 641, 53 USPQ 563, 571-572 (2nd Cir. 1942), cert. den. 317 U. S. 651, 55 USPQ 493. The category of patented unpatentables is large. *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971, 974, 93 USPQ 274, 276 (3rd Cir. 1952), cert. den. 344 U. S. 844, 95 USPQ 418.

2. Plaintiffs characterize the configuration of defendant's 1942 gate plate as "dish-shaped," because the sides were sloping or angular in relationship to the bottom of the plate instead of parallel and perpendicular as specified in claim 3 of the 150 patent. But long before Stock applied for the 150 patent, defendant's advertising had not unreasonably described its 1942 gate as U-shaped. It is not significant that the depth of plaintiff's plate is slightly greater than defendant's 1942 construction, for claim 3 of the 150 patent gives no indication what the depth of the plate shall be.

121 F. 2d 680, 682, 50 USPQ 87, 89 (3rd Cir. 1941). But when the combination consists merely of old and familiar mechanical features which used together perform only the several normal and familiar functions which they have long been known and employed to perform separately, the combination is not patentable. *Alco Kar Kurb Inc.* v. *Ager*, 286 F. 2d 931, 932, 128 USPQ 269, 270 (3rd Cir. 1961). An accumulation of old elements is patentable as a combination only when the whole in some way exceeds the sum of its parts. This is unusual when old mechanical elements are involved. *Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 152, 87 USPQ 303, 305-306 (1950).

In asserting the inapplicability of this principle, plaintiff argues that the combined effect of the elements of claim 3 provide valves manufactured in accordance with its teachings with a unique advantage over other valves when used in connection with pressure or cyclone furnaces. Stock, the patentee, testified that pressure furnaces came into common use only in the last five or ten years, and that the development of the cyclone burner, a particular type of pressure furnace manufactured by the Babcock & Wilcox Co., began about 1950 and was finished sometime prior to the 1950 patent.

Stock stated that although coal dust had always existed in the valve casing even before the introduction of pressure type burners, with the advent of the pressure furnace air pressures built up at certain times in the valve casings and created dust conditions in the casings far worse than when the valves were used with furnaces of non-pressure types. The chief advantage claimed for plaintiff's valve over that which defendant had been manufacturing since 1942 is that plaintiff's structure prevented the rack and pinions from becoming clogged with coal dust which prevented movement of the gate plate.

The evidence fails to substantiate this claim. Stock testified that coal dust had clogged the rack and pinions in the valve manufactured by the plaintiff under its 296 patent and that as a result the teeth were frequently broken and the gate plate rendered unusable. The coal valve which the plaintiff manufactured under its 296 patent, however, had a solid rack construction in contrast with the open tooth rack which defendant had been using in its valves since 1942. On cross-examination, Stock admitted that he knew of no instance in which a coal valve such as defendant had manufactured since 1942 had failed due to coal dust clogging the rack and pinions. The 150 patent itself makes no claim that the alleged invention was an improvement over an open tooth rack valve, but asserts superiority over the solid rack construction described in plaintiff's 296 patent.

Stock theorized in some detail about the air activity which occurred inside of a casing when a coal valve is used with a pressure furnace, and clogging problems which would exist under the defendant's 1942 type of valve. When heard the testimony was far from convincing and indeed scarcely comprehensible. A reading of the transcript has not improved it.

Neither the application for the 150 patent as originally filed, nor the patent itself suggests that the cyclone or other types of pressure furnaces created special problems of dust accumulation which necessitated the structure claimed in the 150 patent. The theory that the 150 patent fulfilled a need created by pressure furnaces appears to be at best an unconvincing afterthought.

In any event claim 3 of the 150 patent disclosed nothing more than a combination of elements which were well known in the art for many years and together perform only the several normal and familiar functions they have long been

known to perform separately. The combination involved no invention, and claim 3 of the 150 patent is invalid.

Other contentions made by the parties concerning the validity of claim 3 of patent 150 have been considered. Either they are lacking in merit or the view previously expressed makes a discussion of them unnecessary.

The parties have stipulated that if claim 3 of the 150 patent should be adjudged invalid, claims 1, 2, 4, 5, and 6 are also invalid.

[3] Plaintiff (sic) asks the court to award it reasonable attorneys fees under the authorization of 35 U. S. C. § 285. This section was enacted to prevent gross injustice in patent litigation. It has been indicated that fraud practiced upon the Patent Office or vexatious or unjustified litigation are adequate reasons for awarding attorneys fees. *Pennsylvania Crusher Co.* v. *Bethlehem Steel Co.*, 193 F. 2d 445, 451, 92 USPQ 31, 35 (1951).

Here it is claimed by defendant that the Patent Office was induced to issue the 150 patent as a result of fraud perpetrated upon it by Stock. The fraud is said to consist of Stock's sworn claim of inventorship of a valve which he knew was anticipated by a valve that the defendant had been manufacturing and selling since 1942, and his failure to disclose to the Patent Office defendant's 1942 gate construction.

On cross-examination Stock admitted that claims 1 and 6 of the 150 patent which eventuated on his application were indistinguishable from defendant's 1942 valve.[3] Stock also conceded that when he made his affidavit he knew of the construction of defendant's 1942 valve and that it had been on the market in competition with valves manufactured by

3. While Stock made no similar concessions to claim 3, defendant's 1942 valve was essentially the same as that specified in claim 3, except in the inconsequential aspects previously indicated.

plaintiff for quite a number of years. Stock stated, however, that at the time when he made his affidavit he had the "feeling" that he was the inventor, and that he "did not necessarily compare (his application) to the Beaumont Birch job." Taking this testimony in its entirety it is at least inferable that when Stock executed the affidavit stating that he was the inventor of the device disclosed in his application, he did not then specifically have in mind the structure of defendant's valve even though he had theretofore known of it. So viewed, if Stock's testimony is believed, his affidavit although untrue, was not a deliberate falsehood, but the result of an oversight.

Defendant also points to the fact that on May 14, 1956 Stock and his attorney appeared before an examiner in the Patent Office and demonstrated two valves—one manufactured under the Stock 296 patent and one built in accordance with Stock's pending application. Stock testified that at the time of the conference he knew of the 1942 valve which defendant had been manufacturing and selling, but that neither he nor his lawyer informed the examiner of it. Stock said that "We were just demonstrating the difference between our old gate and the new one", and that "I didn't think it (defendant's structure) was pertinent at the time." The reason which Stock thus assigned for not telling the examiner about defendant's structure; i.e. its irrelevance, indicates that Stock's non-disclosure was a matter of deliberate choice and not inadvertent. Stock's statement that he considered defendant's prior instructions irrelevant is of dubious acceptability. He was not entirely inexperienced in the matter of patent applications.[4] It is at least a reasonable inference that Stock realized that a disclosure of defendant's 1942 valve structure would jeopardize the allowance of his application and

4. He had applied for his 296 patent in 1938. At the trial he said he was the recipient of between ten and twenty patents.

remained silent to avoid this consequence. The evasive, unresponsive and argumentative way in which Stock frequently testified at the trial tends to buttress such a conclusion.

But whether Stock's Patent Office activities were motivated by a deliberate desire to deceive, or are assessed in a more charitable light, is not too important. Whatever be the true reason, it is fair to conclude that the 150 patent would not have issued if the Patent Office had been apprised of defendant's earlier valve. Even though Stock be given the benefit of the doubt, the fact remains that the trouble and expense which defendant has been put to in defending the present suit has been the result of Stock's inexcusable conduct in his patent prosecution. Under the circumstances it is grossly unjust that defendant should bear the burden of the litigation. The case is an exceptional one within the purview of 35 U. S. C. § 285. Equity requires that plaintiff pay reasonable attorneys fees to defendant. They will be awarded in an amount to be determined after the judgment entered hereon becomes final.

This opinion shall be deemed to contain the findings of fact and conclusions of law required by FRCP 52(a).

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IN THE

Supreme Court of the United States

October Term, 1966
No. 1225

THE COLSON CORPORATION,

Petitioner,

vs.

EVEREST & JENNINGS INC., GERALD M. JENNINGS, HARRY C. JENNINGS, JR., and DAVID D. JENNINGS,

Respondents.

Brief of Respondents, Everest & Jennings, Inc., Gerald M. Jennings, Harry C. Jennings, Jr., and David D. Jennings, in Opposition to Petition for Writ of Certiorari.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition for a writ of certiorari should be denied in this case for the following reasons:

(1) There are no conflicting decisions by Circuit Courts of Appeal of different circuits on questions requiring reconciliation or resolution by this Court.

(2) The Circuit Court of Appeals for the Seventh Circuit affirmed the district court and expressly refused to find bad faith on the part of respondents.

(3) The record shows that the wheel chair patent in suit was held invalid by the Circuit Court of Appeals for the Seventh Circuit for failing to meet the nonobviousness requirement of 35 U.S.C.A. 103 and not for anticipation by respondents' prior wheel chair alone.

Concurrent Conclusions of the District Court and Circuit Court of Appeals Will Not Ordinarily Be Disturbed.

In *Universal Oil Products Co. v. Globe Oil Refining Co.*, 322 U.S. 471, this Court held:

> "Where the question presented by the contested claims of infringement and validity are purely factual, this Court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases. Goodyear Co. v. Ray-O-Vac Co., 321 U.S. 275 (60 USPQ 386)."

In *Goodyear v. Ray-O-Vac, supra,* this Court stated:

> "The Circuit Court of Appeals re-examined the findings in the light of the evidence and accepted them. It must be a strong case in which this court will set aside these concurrent findings of two courts." (citing *Williams Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 367.)

Petitioner has attempted to show alleged conflict of decisions in different circuits on the question of allowance of attorney's fees upon findings of bad faith in connection with knowledge of prior art and prior public use of the patented devices.

In support of its position petitioner cites *Shingle Product Patents, Inc. v. Gleason,* 211 F. 2d 437 (9th

Cir.), and *Talon, Inc. v. Union Slide Fastener, Inc.*, 266 F. 2d 731 (9th Cir. 1959). Petitioner also cites *Walker Process Equipment Inc. v. Food Machinery and Chemical Corp.*, 382 U.S. 172 (1965), which reversed the Seventh Circuit Court of Appeals, and in which this Court held that patents procured by fraudulently concealing prior art are not entitled to anti-trust exemption. Petitioner also cited *Stock Equipment Co. v. Beaumont Birch Co.*, a Pennsylvania district court case apparently reported only 140 USPQ 134.

In the Ninth Circuit *Shingle Product* and *Talon* cases, the *Walker Process* case of this Court and the *Stock Equipment* case of the Pennsylvania district court, bad faith was found.

The fact that this Court overruled the Seventh Circuit Court of Appeals in the *Walker Process* case and rendered an opinion in agreement with *Shingle Product, Talon* and *Stock Equipment*, firmly establishes the law *where bad faith was found.*

In the present case, the district court did not find bad faith and refused to allow defendant-petitioner attorneys' fees.

Conclusion of Law 6 reads:

> "Defendant is entitled to judgment with costs. Defendant is not entitled to an allowance of attorneys' fees." (P. App. 269).*

The Circuit Court of Appeals for the Seventh Circuit discussed *Townsend Company v. M.S.L. Industries,*

*Plaintiffs-Respondents' Appellate Appendix.

7th Cir., 359 F. 2d 814 (1966) relied upon by petitioner before the Circuit Court. In distinguishing from *Townsend,* the Seventh Circuit Court of Appeals stated:

> "In Townsend, the trial court found the plaintiffs had brought their action in bad faith. The question on appeal was the propriety of the trial court's issuance of summary judgment, that is, whether there existed a genuine issue of material fact. Finding no such issue of fact, this court upheld the summary judgment of the trial court.
>
> "In the instant case, there was a trial, and the trial court, while finding and concluding the '449 patent invalid for anticipation and lack of patentable invention and not infringed by Colson's constructions, made no finding of bad faith in the application for the patent, and denied Colson an allowance of attorneys' fees.
>
> "Where the trial court has made no finding of bad faith, such a finding cannot readily be made on review from a cold record, we find none here. Cf. Talon, Inc. v. Union Slide Fastener, Inc., 9 Cir. 266 F. 2d 731, 739 (1959).
>
> "We hold that the district court did not abuse its discretion in failing to award attorneys' fees because of the alleged bad faith of Jennings." (Petition pp. 20-21).

In the cases cited by petitioner, bad faith was found and attorneys' fees were awarded. In the instant case, bad faith was expressly not found, and consequently, attorneys' fees were not awarded. This does not amount to a conflict of decisions. It is merely the application of the law to different sets of facts. The guide lines are clear and the decisions require no reconciliation by this Court.

The Fact That Neither the District Court nor the Circuit Court of Appeals Found the Patent to Be Anticipated by Respondents' Prior Construction Alone, but With That Construction in View of Prior Patents From a Different Art, Is of Itself Strongly Indicative That Respondents Were Not Guilty of Bad Faith.

The district court in Finding of Fact 6 stated:

> "The whole combination of elements purporting to be patented in the patent in suit, and every feature of alleged novelty of each element, *excepting only the pintle hinge (with pintles of equal or unequal length) of the patent compared with the bolt and nut hinge of prior use,* had been in public use and on sale and sold in commerical quantities, by plaintiffs and their predecessors for more than one year before the plaintiff filed the application for the patent in suit." (Emphasis supplied) (App. p. 262).
>
> "These charges comprised no more than the mere choice and selection of size and shape among old devices, with the result of but small increased or change efficiency and convenience." [Finding of Fact 8, P. App. p. 264].

The Circuit Court of Appeals for the Seventh Circuit, in concluding its opinion held:

> "In sum we hold that the patent in suit clearly fails to meet the nonobviousness requirement of 35 U.S.C.A. §103, and that there was no showing of bad faith requisite to justify an award of attorneys' fees." (Petition 21).

In Its Effort to Convince This Court That Respondents Acted in Bad Faith, Petitioner Has Erroneously Represented That "None of the Claims of This Patent, Albeit Invalid, Had Been Infringed by Colson." (P. App. p. 269.)

Upon defendant-petitioner's own motion, the district court ordered an amendment to Conclusion of Law 5. Original Conclusion of Law 4 (P. App. p. 269) reads:

> "None of the claims of Patent No. 2,592,449 has been infringed by defendant."

The order of the Court (P. App. p. 283) reads:

> "Conclusion of Law 5 delete the period and add the following:
>
> 'except as the accused form, Exhibit 20, was conceded to infringe if the patent were valid, and except as to the accused form of Exhibits 21, R and 65 wherein the pintles were of unequal length.' ".

Conclusion.

It is respectfully submitted that petitioner's contentions are without merit and that the petition should be denied.

Respectfully submitted,

ALLAN D. MOCKABEE,
ROY E. HOFER,
Attorneys for Respondents.

Certificate of Service.

It is hereby certified that copies of BRIEF OF RESPONDENTS, EVEREST & JENNINGS, INC., GERALD M. JENNINGS, HARRY C. JENNINGS, JR., AND DAVID D. JENNINGS, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI were delivered this 1st day of May, 1967, to the office of Lowell E. Sachnoff, 105 West Adams Street, Chicago 3, Illinois.

ROY F. HOFER
Attorney for Respondents.